



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/750,138	12/29/2000	Dale W. Malik	BS00-170	6782

7590 01/26/2007
JEFFREY R. KUESTER, ESQ.
THOMAS, KAYDEN, HORSTEMEYER @ RISLEY, LLP
100 GALLERIA PARKWAY
SUITE 1750
ATLANTA, GA 30339

EXAMINER

NEURAUTER, GEORGE C

ART UNIT	PAPER NUMBER
----------	--------------

2143

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/26/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/750,138

Applicant(s)

MALIK, DALE W.

Examiner

George C. Neurauter, Jr.

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3, 6-8, 15 and 21-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 6-8, 15, and 21-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2143

DETAILED ACTION

Claims 1-3, 6-8, 15, and 21-45 are currently presented and have been examined.

Response to Arguments

Applicant's arguments filed 3 January 2007 have been fully considered but they are not persuasive.

The Applicant argues that Shaffer does not teach or suggest the step of determining whether an electronic mail message has been previously compressed. The Examiner is not persuaded by these remarks in view of the teachings of Shaffer.

Shaffer discloses:

"According to the invention, when indicated by the connection or channel speed and the message or attachment size, a server makes a compressed version of the data file available for transmission." (column 7, lines 46-49)

"A system according to a specific embodiment of the invention can use artificial intelligence type analysis in media server 210 or a cooperating software component to determine when or how to compress messages..." (column 7, lines 11-14)

In view of the teachings of Shaffer and the knowledge of one of ordinary skill in the art, the server is able to determine whether an electronic mail message has been compressed by a predetermined criteria such as the message's size or some

Art Unit: 2143

other predetermined criteria and then, based on the indication, compresses the message. By definition, compression of a data file comprises the act of reducing the size of a file to some value that is less than the original size of the file. Since the claim fails to specifically recite and therefore require how a message may be previously compressed in some other manner than that is conventionally known, the server determines to compress a message, for example, based on its message size, and then compresses the file. As also shown in Shaffer, a file may be compressed into a variety of compressed formats (column 8, lines 45-56). As shown by this disclosure in Shaffer and is also conventionally known, a file may have an infinite number of varying degrees of compression. Therefore, the Examiner has interpreted the limitation "previously compressed" to mean that the file is either in a compressed format at the time of determination whether it has been compressed and therefore is considered to be "previously compressed" or it is not compressed, leading the server to compress the file. As shown previously, the claim fails to specifically recite a specific context in which a file is considered to be "previously compressed". Therefore, in view of the teachings and suggestions of Shaffer, Shaffer does disclose this limitation and the currently presented claims are not in condition for allowance.

Art Unit: 2143

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 6-8, 15, and 21-45 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6 842 768 B1 to Shaffer et al.

Regarding claim 1, Shaffer discloses a method for automatically managing an electronic mail server application on a host computer, comprising the steps of:

checking an electronic mail message against a predetermined criteria; determining whether the message has been previously compressed; compacting ("compressing") a non-attachment portion (referred to within the reference as "message") of the electronic mail message if the predetermined criteria is satisfied and if the message has not been previously compressed; and storing the compacted electronic mail message. (column 7, lines 46-51, specifically "...when indicated by...the

Art Unit: 2143

message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account..."; column 6, lines, 65-67, "The figure shows a representation of multimedia email system 210 with individual original messages 252 and !compressed (sp) messages 254.")

Regarding claim 2, Shaffer discloses the method of claim 1, wherein the step of checking is performed when the electronic mail message is received by the electronic mail server application. (column 3, lines 25-29, "Device 130 represents any type of device or system or network that provides data to user information appliances, such as, but not limited to...an email server..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account...") (Examiner's note: Note that it is inherent within the reference that email servers receive and store messages for clients before the clients access their email account).

Regarding claim 3, Shaffer discloses the method of claim 1, wherein the step of checking is performed when the electronic

Art Unit: 2143

mail message is performed periodically on the host computer.

(column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account or the file may be compressed on-the-fly as a user logs in or as a user requests download of a particular message")

Regarding claim 6, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises a total message size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 7, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises an attachment size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a

Art Unit: 2143

compressed version of the data file available for transmission.")

Regarding claim 8, Shaffer discloses the method of claim 1, wherein the predetermined criteria comprises an attachment type. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission."; column 8, lines 7-10, "Other parameters according to the invention may indicate what decoding formats can be handled by the client and therefore allow a server to determine desired compression formats.")

Regarding claim 15, Shaffer discloses the method of claim 1, further comprising the step of compressing the attachment. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 21, Shaffer discloses a method for managing a user's electronic mailbox on a computer, comprising the steps

Art Unit: 2143

of performing an off-peak hours routine (column 8, lines 30-34, "An intelligent component of the system might also defer performing any pre-compression while the computer system is experiencing heavy use or might defer pre-compression") for checking an electronic mail message against a predetermined criteria; compressing a non-attachment portion of the electronic mail message if the predetermined criteria is satisfied, wherein the step of compressing the electronic mail message is performed by searching for repeated patterns in the electronic mail message and encoding those patterns (column 8, lines 45-56); and storing the compressed electronic mail message. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account..."; column 6, lines, 65-67, "The figure shows a representation of multimedia email system 210 with individual original messages 252 and !compressed (sp) messages 254.")

Regarding claim 22, Shaffer discloses the method of claim 21, wherein the step of checking is performed when the electronic mail message is received by the electronic mailbox. (column 3, lines 25-29, "Device 130 represents any type of

Art Unit: 2143

device or system or network that provides data to user information appliances, such as, but not limited to...an email server..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account..." (Examiner's note: Note that it is inherent within the reference that email servers receive and store messages for clients in their respective accounts or "mailboxes" before the clients access their email account).

Regarding claim 23, Shaffer discloses the method of claim 21, wherein the step of checking is performed upon request by the user. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file...or the file may be compressed on-the-fly as a user log ins or as a user requests download of a particular message.")

Regarding claim 26, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises a total message size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression

Art Unit: 2143

ratio for a message..."; column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 27, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises an attachment size. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 28, Shaffer discloses the method of claim 21, wherein the predetermined criteria comprises an attachment type. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a...message attachment"; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission."; column 8, lines 7-10, "Other parameters according to the invention may indicate what decoding formats can be handled by the client and therefore allow a server to determine desired compression formats.")

Art Unit: 2143

Regarding claims 30-32, Shaffer discloses the method of claim 21, wherein the location of the screening of the message is on a server, a client, or configured by a user. (column 2, lines 39-48, specifically "...the size of the data transfer...is used to select an appropriate compression ratio for a message... In specific embodiments, a user may indicate (either at the time of transfer, the time of login, or during client setup) an acceptable delay or desired compression for a transfer."; column 7, lines 46-51, specifically "...when indicated by...the...attachment size, a server makes a compressed version of the data file available for transmission.")

Regarding claim 33, Shaffer discloses the method of claim 21, wherein the screening is performed periodically on the computer. (column 7, lines 46-51, specifically "...when indicated by...the message...size, a server makes a compressed version of the data file available for transmission. This compressed data file may be prepared by the server by a compression engine 260 before a user ever accesses an email account or the file may be compressed on-the-fly as a user logs in or as a user requests download of a particular message")

Regarding claim 34, Shaffer discloses the method of claim 21, wherein the electronic mail message is compressed into a zipped file. (column 8, lines 45-56, specifically "It should be

Art Unit: 2143

understood that a data file or a message may be encoded into a variety of compression formats. Some of these formats, such as ...ZIP...have built-in variable compression.")

Claims 35-42 are also rejected since these claims recite a computer readable medium that contain substantially the same limitations as recited in claims 21-23, 33, 26-28, and 34 respectively.

Regarding claim 43, Shaffer discloses the method of claim 1, further comprising decompacting the compacted electronic mail message for retrieval. (column 5, lines 30-44, specifically "Optionally, there may also be a selectable option that a user can use to indicate that the system should download a compressed file or original file according to default rules. Selection by a user is registered by the client-side logic (Step B3) and is communicated so that the appropriate file format may be transmitted (Step B4)."; column 8, lines 35-45, specifically "The server maintains information about which algorithms are available at a particular client and may learn from the client from time to time which algorithms are available at the client or desired by the user such as via a compression format list 250. According to a further embodiment, a server can in some instances download to the client an application or applet 240 to

Art Unit: 2143

enable the client to handle a particular type of compressed file")

Claims 44 and 45 are also rejected since these claims recite a method and computer readable medium that contains substantially the same limitations as recited in claim 43.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to George C. Neurauter, Jr. whose telephone number is 571-272-3918. The examiner can normally be reached on Monday-Friday 9am-5:30pm.

Art Unit: 2143

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wiley, can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

gcn


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100